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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,781	06/12/2002	Vincenzo Vassarotti	3568.069	3766

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,781

Applicant(s)

VASSAROTTI, VINCENZO

Examiner

Krishnan S Menon

Art Unit

1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7,8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,7,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 5,7,8 and 10 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 10 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vassarotti (US 5,647,990).

Vassarotti teaches a membrane filtration device comprising a two-sided filtration insert (see figures) comprising

an upper plate having at least one concentration chamber (3-fig 2) adapted to receive and contain a liquid containing macromolecules to be processed, each of said at least one concentration chamber being provided with at least one first aperture (covered by membrane 22); a membrane support plate (23) having at least one filtrate chamber for supporting the permeate side of at least one membrane (22), said at least one filtrate chamber (on 21 under 23) provided with at least one second aperture arranged over said at least one first aperture (opening upward from bottom side of 23-fig 2); at least one membrane (22) having a feed side and a permeate side, said membrane being fluid-tight along its periphery and situated over at least one of said first and second apertures and separating said at least one concentration chamber and said at least one filtrate chamber, and elastic gasket means (24) arranged around at least one of said

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first and second apertures and in contact with at least one side of said at least one membrane, and (b) a two-part pressure-resistant sleeve (25-fig 7 and 8; col 5 lines 1-19) separate from said filtration insert and matingly engaging said upper plate and said membrane support plate of said filtration insert so as to exert and maintain sufficient compressive forces to seal said at least one membrane fluid-tight against said concentration chamber and said filtrate chamber.

Equivalents: the gasket 24 is not described as 'elastic' in the reference (col 4 lines 17-42), but is equivalent. The sleeve 25 is one integral piece and not two-part as in the claim, but is equivalent (col 5 lines 1-31). In this case, the prior art elements perform the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Also, making integral (one piece) or separable (two-part) would be a matter of obvious engineering choice (*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965); *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)). One could consider the sleeve 25 as two-part with its mating part at the base of reservoir 1 to which sleeve 25 butts against. It may also be noted that applicant's two pieces must be assembled into one for usage.

Claim 5: gasket can be integral – see col 4 lines 33-43.

2. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vassarotti (990) in view of Root et al (US 4,948,564).

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Vassarotti teaches all the elements of claim 10. Claims 7 and 8 add plurality of concentrate and filtrate chambers with membranes adapted for a microtiter plate, which Vassarotti does not teach. Root teaches such plurality of concentrate and filtrate chambers separated by membranes forming a microtiter plate (see figures and col 6 lines 56-65). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Root in the teaching of Vassarotti to make the microtiter plate for treating large number of samples simultaneously.

3. Claims 5,7,8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Root et al (US 4,948,564)

Root teaches a device for concentrating macromolecules comprising two-sided filtration insert (fig 14) having upper plate (18) having plurality of concentration chambers (20-fig 14), filtrate chambers (78), membranes (34), membrane support plate (201), first and second apertures (bottom of 20 and top of 78) with two-part sleeve (200 and 220) for holding them together in a pressure-tight manner (see fig 14), and forming micro-titer plate as in instant claims (see col 6 lines 56-65). Equivalents: the membrane has no gasket in Roots, but is equivalent to an integral gasket (Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000))

Response to Arguments

Applicant's arguments filed 11/16/03 have been fully considered but they are not persuasive.

Applicant's arguments have the base that Vassarotti and Root references do not teach two-part pressure resistant sleeves, which is addressed in the rejection.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Krishnan Menon
Patent Examiner


W. L. WALKER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER